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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004US1 (590.059)	6136
35195 7590 09/14/2011 FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/787,753	Applicant(s) ABAD-PEIRO ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1,2,5-9,21-26 and 28-31 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1, 2, 5-9 and 21-26 and 28-31 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This application has been reviewed. The status of the claims is as follows: claims 1, 2, 5-9 and 21-26 and 28-31 were previously pending; claims 25, 26 and 31 have been amended; no claims have been added, cancelled or withdrawn; therefore, claims 1, 2, 5-9 and 21-26 and 28-31 are currently pending and have been examined. The rejections are as follows.

Response to Amendment

1. The amendments have been reviewed against the specification and accepted for examination.

Response to Arguments

2. Applicant's arguments, see pages 10-11, filed June 28, 2011, with respect to 35 USC 112 Rejection(s) have been fully considered and are persuasive. The 35 USC 112 Rejection(s) of 1, 2, 5-9 and 21-26 and 28-30 has been withdrawn.

3. Applicant's arguments, see page 12, filed June 28, 2011, with respect to the rejection(s) of claim(s) 1, 2, 5, 6, 21-23 and 31 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made: Regarding the last limitation, stating that only the certified trusted third party knows the identity of one or more users issuing the one or more requests, the Examiner previously cited Sirbu et al. (US 5,809,144) as disclosed a purchasing system that allows for separation

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between the merchant and the user by allowing the user (element 10) and the merchant (element 22) to each connect to the third party ("product server", element 57) independently, see figure 4. Rowney discloses various systems (such as Sirbu), electronic funds transfer systems, as well known in the art, see column 1 (line 55) through column 2 (lines 27, 56-67) and column 3 (lines 1-45). Now, for the purposes of compact prosecution, the Examiner cites Sosa et al. (US Patent 7,814,018) as disclosing an anonymous customer and a transaction performed by a certified trusted third party (see Abstract and column 7, lines 26-39).

4. Please note: the Examiner is also sending out this Office Action as a non-final because an additional meeting was supposed to be held between the Examiner and the Applicant's representative. In the last interview held on June 17, 2011, the Examiner informed the Applicant's representative that if there were additional issues with the Application, preventing it from going towards allowance that the Examiner would contact the Applicant's representative. However, after an allowance conference was held in this application it was deemed that this application is not in condition for allowance. The Examiner was not able to contact the Applicant's representative to discuss the issues in detail. Therefore, in the interest of fairness, the Examiner is sending this Office Action as a non-final.

5. Applicant's arguments filed June 28, 2011, with respect to the Rowney reference have been fully considered but they are not persuasive. The Applicant points out that the invention as claimed is a clearly different system and Rowney (see pages 12-15) because of the use of two separate communications links. However, the Examiner

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contends that the way the claims are written, still allows for two separate communications links "between" the user and the gateway (third party). The Examiner points out that the claim limitations are still extremely broad and that the Internet provides for the use of multiple communications links between the parties.

6. The amendments to claim 1 disclose: receiving a request for product from user computing devices utilizing a first network link between the user and the certified trusted third party. The Examiner points out that Rowney does disclose a first communications link that is between the user and the third party gateway (see element 150). Rowney also discloses a second communications link that is between the third party gateway and the merchant (see element 170).

7. The Examiner further points out issues with the last limitation of claim 7, which states: "wherein the user need only communicate with the certified trusted third party on the first network link to complete an entire transaction." This limitation is not definitive. The use of "need only" only suggests a capability, instead of requiring that the user communicate only with the certified trusted third party on the first network link in order to complete the transaction.

Claim Rejections - 35 USC § 102

8. Claims 7-9, 24, 25 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowney et al. (US 5,987,140), hereafter referred to as Rowney.

9. Regarding claims 7, 9, 24, 25 and 29, Rowney discloses:

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- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract
- b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)
- c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
- d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
- e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).
- f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
- g. a first communications link that is between the user and the third party gateway (see element 150).
- h. Specifically regarding claim 25: Rowney discloses a server (Abstract) with a central processing unit (element 10 of figure 1A)
- i. The client communicates with a hello message in order to start communications with a merchant (see column 10, line 25 through column 12, line 11).

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- j. Product information and product order information (i.e. payment information) is then sent to the customer [see column 11, line 59 through column 12, line 11; and, fig. 2, elements #210-270 and fig. 3, elements #315, #325].
 - k. Completing the entire transaction using the certified trusted third party (see fig. 1B, column 10, lines 4-19).
10. Regarding claim 8, Rowney discloses the use of the JAVA protocol in column 4 (lines 20-31).
11. Regarding claim 28, Rowney discloses receiving keyboard input, see element 24 and column 13 (lines 29-67).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 5, 6, 21-23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney in view of Sosa et al. (US Patent 7,814,018), hereafter referred to as Sosa.
14. Regarding claims 1 and 31, Rowney discloses:
- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract

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- b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)
- c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
- d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
- e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).
- f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
- g. a first communications link that is between the user and the third party gateway (see element 150).
- h. Specifically regarding claim 25: Rowney discloses a server (Abstract) with a central processing unit (element 10 of figure 1A)
- i. a first communications link that is between the user and the third party gateway (see element 150).
- j. a second communications link that is between the third party gateway and the merchant (wee element 170).

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k. The client communicates with a hello message in order to start communications with a merchant (see column 10, line 25 through column 12, line 11).

l. Product information and product order information (i.e. payment information) is then sent to the customer [see column 11, line 59 through column 12, line 11; and, fig. 2, elements #210-270 and fig. 3, elements #315, #325].

15. As disclosed above, the last limitation of claim 1 discloses the phrase, "only the certified trusted third party knows an identity of one or more users". Rowney discloses various systems, electronic funds transfer systems, as well known in the art, see column 1 (line 55) through column 2 (lines 27, 56-67) and column 3 (lines 1-45). However, Rowney does not specifically disclose a system where the merchant does not have to contract the user directly. The Examiner cites Sosa as disclosing an anonymous customer using a trusted third party to perform a transaction (see Abstract and column 7, lines 26-39). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to allow the user to be anonymous to the merchant and perform a transaction using a third party payment system because it is a secure way to provide a anonymous transaction (see Sosa, column 2, lines 15-25).

16. Regarding claim 5, Rowney discloses providing confirmation of payment (the payment capture response) in figure 13F (element 925).

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17. Regarding claim 6, Rowney discloses the information in claim 1. Rowney also discloses: utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42); and, utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).

18. Regarding claim 22, Rowney discloses the use of the SET payment protocol in column 4 (lines 59-62).

19. Regarding claim 23, Rowney discloses establishing a trusted third party via an authentication/certificate in column 11 (lines 14-17) and receiving a request from a non-certified party, see figure 4 and column 12 (lines 13-24).

20. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Sosa as applied to claim 1 above, and further in view of Shavit (US Patent 4,799,156), hereafter referred to as Shavit.

21. Regarding claims 2 and 18, Rowney discloses a terminal interface in figure 1A (element 38), the processing user requests at using a computing device (see figure 1A), and presenting an interactive window and allowing a user to choose competitive products in column 2 (lines 7-42). Rowney does not specifically disclose the use of insurance services. Shavit discloses that a payment / transaction system can interconnect with insurance services in column 7 (lines 6-9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to include the act of connecting to insurance services because

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this type of connection was old and well known in the art at the time this invention was made and according to Shavit, is also allows for businesses to achieve additional levels of efficiency (see column 1, lines 13-23).

22. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Sosa as applied to claim 1 above, and further in view of Rosen (US 5,671,280), hereafter referred to as Rosen.

23. Regarding claim 21, Rowney and Sirbui do not specifically disclose the use of a mobile communications devices. Rosen discloses the use of mobile communications devices in commercial payment systems, see column 5 (lines 30-38). Therefore, it would have been obvious to a person having ordinary skill in the art at the time this invention was made to modify Rowney and Sirbu to include the use of mobile communications devices because it sets up communication with devices used in the “outside world” (see column 5, lines 31-32), thus allowing access to the system by more users.

24. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Fox et al. (US Patent 6,560,581), hereafter referred to as Fox.

25. Regarding claim 26, Rowney discloses: a “direct or physical” interfaces for the user in figure 1A, element 28; a keyboard (fig. 1A, element 24); and, a card reader configured to receive and process payments made with a bank or smart card. Rowney does not disclose an a card reader. However, Fox discloses a card reader used in

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electronic commerce for payment of a transaction (see Abstract, fig. 10, element #160 and column 16, lines 46-58). Therefore, it would be obvious to a person having ordinary skill in the art at the time this invention was made to modify Rowney to include the use of a card reader because it is a convenient and efficient way for users to pay for their merchandise.

26. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Shavit, hereafter referred to as Shavit.

27. Regarding claim 30, the Examiner discloses that it is possible for the requests/purchases in Rowney to be insurance services. However, Rowney does not specifically disclose the use of insurance services. Shavit discloses that a payment / transaction system can interconnect with insurance services in column 7 (lines 6-9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to include the act of connecting to insurance services because this type of connection was old and well known in the art at the time this invention was made and according to Shavit, is also allows for businesses to achieve additional levels of efficiency (see column 1, lines 13-23).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is

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(571)272-7976. The examiner can normally be reached on Monday through Friday from 8:30 AM until 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Muriel Tinkler/
Primary Examiner, Art Unit 3691